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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Scott Allan Kendall, et al.
Serial Number: 10/510,057
Atty. Dkt: PU020097
Filing Date: October 4, 2004
For: BROWSER WITH SETTING SAVING FEATURE
Art Unit: 2455
Examiner: Edward J. Kim

REPLY BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

In response to the Examiner's Answer dated September 28, 2009, which replaces the Examiner's Answer dated August 18, 2009, the Appellants hereby submit a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to Mail Stop: Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on NOVEMBER 23, 2009 at facsimile number (571) 273-8300.


Joan Sanders

Response to Examiner's Answer

In response to the Examiner's Answer dated September 28, 2009 (which replaces the Examiner's Answer dated August 18, 2009), Appellants maintain that claims 1-21 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 7,149,982 issued to Duperrouzel et al. (hereinafter, "Duperrouzel").

First, Appellants again note that one of the notable features of the claimed invention is that user settings for a web page are saved in response to a signal for exiting the web page. This feature of the claimed invention is recited in each of the independent claims under appeal as follows:

"e. automatically saving a current state of the viewer adjustable setting in the memory in response to a signal for exiting the web page" (emphasis added; see claim 1),

"b. automatically storing the user-preferred format setting in association with a URL for the web page in response to a signal for exiting the web page" (emphasis added; see claim 5),

"c. means for automatically storing a current user adjustable format preference for the web page in response to a signal for exiting the web page" (emphasis added; see claim 11), and

"a. a code segment for receiving user adjustable format selections for a displayed web page, and for automatically storing a current user adjustable format selection in association with a URL for the displayed web page in response to a signal for exiting the displayed web page" (emphasis added; see claim 16)

On pages 12-13 of the Examiner's Answer dated September 28, 2009, the Examiner admits that Duperrouzel fails to disclose the aforementioned feature of independent claims 1, 5, 11 and 16, but continues to allege that such a feature is obvious without properly citing any prior art reference to support this allegation. Accordingly, Appellants maintain that the instant rejection under appeal is deficient in that the Examiner has not properly established a *prima facie* case of obviousness under 35 U.S.C. §103(a) by citing prior art which discloses or suggests each and every feature of the claimed invention.

Also on pages 12-13 of the Examiner's Answer dated September 28, 2009, the Examiner alleges:

"... Dupperouzel discloses instances where the user manually saves the settings for a web page before leaving a web site ... for subsequent automatic recall of the settings when the website is re-visited in the future ... It would have been obvious to one of ordinary skill in the art ... to modify the teachings of Dupperouzel to automatically save the settings of the web site *upon leaving the web site*, for subsequent automatic recall of the settings when the website is re-visited in the future. One would have been motivated to do so to minimize human intervention for a comfortable user experience, allowing the settings configured prior to exiting the web page to be automatically saved. Various auto-save mechanisms have been used in a plurality of systems for a comfortable user experience and fast-recovery of data." (italics original; underlining added for emphasis)

As indicated above, the Examiner alleges that the motivation to modify Dupperouzel is to "minimize human intervention" and notes that various "auto-save mechanisms" are known. In response, Appellants again note that the Examiner has not produced any prior art to support these allegations. Moreover, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a proper basis for an obviousness rejection under 35 U.S.C. §103(a) unless the prior art suggests the desirability of such a modification (emphasis added). See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" (emphasis added)) and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). That is, under Federal Circuit law, the motivation/desirability to modify a reference under 35 U.S.C. §103(a) must be derived from the prior art itself. Accordingly, since the Examiner has failed to produce any prior art that supports his allegations regarding the motivation/desirability to modify Dupperouzel in the proposed manner, Appellants maintain that the Examiner's proposed modification to Dupperouzel is the clear result of impermissible hindsight reconstruction.

On page 13 of the Examiner's Answer dated September 28, 2009, the Examiner again cites *In re Venner*, 262 F.2d 91, 120 USPQ 193 (CCPA 1958) for the proposition that "broadly providing an automatic means to replace a manual activity which accomplishes the same results is not sufficient to distinguish over the prior art."

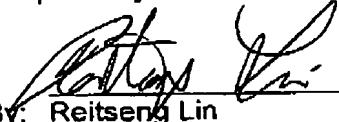
In response, Appellants maintain that the claimed invention is not simply directed towards automating a manual activity, as alleged. Rather, as pointed out in Appellants' previously submitted Appeal Brief, the claimed invention also inherently involves a timing issue, namely the issue of when user settings for a web page should be saved. In particular, the claimed invention recognizes the desirability of saving such user settings at the time of exiting the web page (i.e., in response to a signal for exiting the web page). In contrast to the claimed invention, and as indicated above, Dupperouzel is ostensibly silent regarding the timing of when such user settings for a web page should be saved via the "Take a Snapshot" menu option.

Also pointed out in Appellants' previously submitted Appeal Brief, there are significant advantages associated with saving user settings for a web page in response to a signal for exiting the web page (as claimed), as opposed to saving user settings for a web page via the "Take a Snapshot" menu option (as taught by Dupperouzel). First, by saving user settings for a web page in response to a signal for exiting the web page (as claimed), there is an inherent potential to reduce processor overhead by reducing the number of save operations it must perform. That is, since the user settings for a web page are saved in response to a signal for exiting the web page, there is no need for users to even attempt to save such settings (and thus require processor overhead for a save operation) while they are navigating the web page. This, in turn, advantageously allows users to focus on navigating the web page without having to remember to save their preferred settings for the web page before exiting the same. In this manner, the claimed solution for saving user settings for a web page in response to a signal for exiting the web page effectively eliminates the need for the solution taught by Dupperouzel, wherein users must inconveniently interrupt their web page navigation, access the "Take a Snapshot" menu option, save their settings, and then resume their navigation of the web page. Accordingly, Appellants maintain that their claimed solution

for saving user settings for a web page has significant advantages over the solution taught by Dupperouzel. Moreover, Appellants note with significance that the Examiner has failed to rebut (or even address) the foregoing arguments related to the advantages of the claimed solution over the solution taught by Dupperouzel in the Examiner's Answer dated September 28, 2009.

Accordingly, for at least the foregoing reasons, Appellants maintain that claims 1-21 are patentable under 35 U.S.C. §103(a) over Dupperouzel, and respectfully request that the Board reverse the rejection of claims 1-21, and pass this application to issue.

Respectfully submitted,


By: Reitseng Lin
Reg. No. 42,804
Phone (609) 734-6813

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, New Jersey 08540
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